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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,151	06/16/2005	Ulrich Berens	VT/95-22814/A/PCT	2741
324	7590	07/09/2008	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				NOLAN, JASON MICHAEL
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/539,151	BERENS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JASON M. NOLAN	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 April 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 18-24,31-36 and 41 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 19,21,22,24 and 31-35 is/are allowed.  
 6) Claim(s) 20,23,36 and 41 is/are rejected.  
 7) Claim(s) 18 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on **04/21/2008** has been entered. **Claims 18-24, 31-36, & 41** are pending in the instant application; of which **Claims 20, 23, 24, 31, 33, 34, 36, & 41** are currently amended. **Claims 1-17, 25-30, & 37-40** are canceled.

### *Response to Amendment*

Applicant's amendments with respect to **Claims 20, 23, 24, 31, 33, 34, 36, & 41** have been fully considered and are entered. The 102-prior art rejections of **Claims 20, 23, 36, & 41** over Wegler *et al.*, Shaw *et al.*, Macor *et al.*, & Baudouin *et al.* are withdrawn per amendment. The objection to **Claims 24, 31, 33, & 34** is withdrawn per amendment.

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 20** is rejected under 35 U.S.C. 102(b) as being anticipated by US **5,164,372**. Shown in column 49 is compound 9-(5) which anticipates Formula (XII)

wherein **R2** = H; **n** = 1; **R1** = OH; and **R3 & R4** form a substituted ring together with the nitrogen (proline ring).

**Claim 23** is rejected under 35 U.S.C. 102(b) as being anticipated by Andersen *et al.* (*J. Med. Chem.* **1996**, 39(19), 3723-3738). Shown in Scheme 1 on page 3725 are compounds 8a, 8b, 9a, 9b, 9c, 9d, 9e, etc. which anticipate Formula (XIV) wherein **R2** = H or substituted aryl; **n** = 1; **R1** = halogen; and **R3 & R4** are substituted or unsubstituted alkyl.

**Claims 23 & 41** are rejected under 35 U.S.C. 102(b) as being anticipated by Porter *et al.* (WO 94/14771). The reference teaches compounds according to the Structure (I) on page 1 as well as a number of examples on page 2 that anticipate Formulae (XIV) and (XIV<sup>1</sup>) wherein **R2** = H; **n** = 1 or 2; **R1** = halogen, methyl, aryl, heteroaryl, hydrogen; and **R3 & R4** are substituted or unsubstituted alkyl. For example, 3-[2(dimethylamino)ethyl]-5-phenylindole anticipates both claims.

**Claim 36** is rejected under 35 U.S.C. 102(b) as being anticipated by Macor *et al.* (*Tetrahedron* **1992**, 48(6), 1039-1052). Shown in Scheme 1 on page 1041 is compound 5, which anticipates Formula (XIIla) wherein **R2** = H; **n** = 2; **R1** = hydroxyl, substituted alkyl; and **R3 & R4** are substituted or unsubstituted alkyl.

***Claim Objections***

**Claim 18** is objected to because of the following informalities: there is a definition of **R'** after the definition of **R2** and before **R3 & R4** which is unnecessary since there is no **R'** in the structure according to formula (II). Appropriate correction is required.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is [Jason.Nolan@uspto.gov](mailto:Jason.Nolan@uspto.gov). The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M<sup>c</sup>Kane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jason M. Nolan, Ph.D./

Examiner, Art Unit 1626

/Joseph K McKane/

Supervisory Patent Examiner, Art Unit 1626